

REMARKS

Reconsideration and withdrawal of the rejections set forth in the above-mentioned Official Action in view of the foregoing amendments and the following remarks are respectfully requested.

Claims 34-43, 46-48 and 51-54 are pending with Claims 34, 39, 43, 48 and 53 as being independent. Claims 34, 39, 43, 48 and 53 have been amended. Applicants submit that no new matter has been added.

Claims 34-43, 46-48 and 51-54 are rejected under 35 U.S.C. §103(a) as being unpatentable over Tanaka (U.S. Patent Application Publication No. 2003/0081235) in view of Nishi (U.S. Patent Application Publication No. 2002/0097334).

In response, while not conceding the propriety of the rejection, independent Claims 34, 39, 43, 48 and 53 have been amended. Applicants submit that as amended, these claims are allowable for the following reasons.

Independent Claim 34 relates to an image supply device comprising an interface configured to connect with a storage medium that stores image data.

Claim 34 has been amended to recite that the interface is configured to connect with a storage medium that also stores a file describing a printing condition of the image data before starting communication with a printing apparatus.

Claim 34 also recites a confirmation unit configured to confirm whether it is possible or not to communicate with the printing apparatus using a predetermined protocol upon starting communication with the printing apparatus, and a transmission unit configured to transmit both a print designation created based on the communication with the printing apparatus, after the

confirmation unit confirms that it is possible to communicate with the printing apparatus using the predetermined protocol, and the file to the printing apparatus.

In contrast, the citations to Tanaka and Nishi are not understood to disclose or suggest an interface configured to connect with a storage medium that stores image data and a file describing a printing condition of the image data before starting communication with a printing apparatus, and a transmission unit configured to transmit both a print designation created based on the communication with the printing apparatus, after the confirmation unit confirms that it is possible to communicate with the printing apparatus using the predetermined protocol, and the file to the printing apparatus, as recited by amended Claim 34.

Rather, the citation to Tanaka is understood to merely disclose a printing system in which a printer and a digital camera directly communicate each other and the printer prints an image based on image data supplied from the digital camera. The Office Action notes that paragraph [0063] of Tanaka states, in part: "Designation of a print image in the digital camera 3012 is basically the same as an operation of creating a DPOF file when developing (printing) of sensed images is ordered for a Photo print shop". Tanaka, however, is understood to be silent about the transmission of the DPOF file from the digital camera to the printer in order to designate a print condition of image data. Nishi is understood to disclose that 1) a digital camera has a DPOF dedicated switch 41 for generating or editing a DPOF file, and 2) the digital camera transmits the DPOF file to the printer and the printer reads the DPOF file and creates a print job. But neither Tanaka, nor Nishi, is understood to teach or suggest the transmission of both a print designation created based on a communication with a printing apparatus and the file describing a printing condition of image data. The Office Action argues that because a DPOF file is transmitted to the

printer in Nishi, that it would be obvious to have Tanaka's system “send a printing method file to the printer”. But amended Claim 34 does not recite the sending of a printing method file to a printer. Amended Claim 34 now recites an interface configured to connect with a storage medium that stores a file describing a printing condition of image data before starting communication with a printing apparatus, and a transmission unit configured to transmit the file to the printer.

MPEP § 2142 states that the “key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious”. Here, the Office Action does not satisfy this test since the Office Action has not addressed the obviousness of modifying the references to include an interface configured to connect with a storage medium that stores a file describing a printing condition of image data before starting communication with a printing apparatus, and a transmission unit configured to transmit the file to the printer, as recited by amended Claim 34. For these reasons, Applicants respectfully submit that a prima facie case of obviousness has not yet been established against amended Claim 34. Therefore, Applicants respectfully request that the rejection of amended Claim 34 be withdrawn. And since corresponding image-supply-device method Claim 39, corresponding printing apparatus Claim 43, corresponding printing-apparatus method Claim 48, and corresponding digital camera Claim 53 have been amended in a similar manner, a prima facie case of obviousness has not yet been established against these claims. Therefore, Applicants respectfully request that the rejection of amended Claims 39, 43, 48, and 53 also be withdrawn.

Dependent Claims 35-38, 40-42, 46, 47, 51, 52, and 54 are also allowable, in their own right, for defining features of the present invention in addition to those recited in their respective independent claims. Individual consideration of the dependent claims is requested.

Applicants respectfully request that this Amendment After Final be entered. This Amendment was not presented earlier as it was earnestly believed that the claims on file would be found allowable. Given the Examiner's familiarity with the application, Applicants believe that a full understanding and consideration of this Amendment would not require undue time or effort by the Examiner. Moreover, Applicants submit that this Amendment places the application in condition for allowance. Accordingly, entry of this Amendment is believed to be appropriate and such entry is respectfully requested.

In view of the above amendments and remarks, the application is now in allowable form and entry of this Amendment is considered proper. Therefore, early passage to issue is respectfully solicited.

Applicants' undersigned attorney may be reached in our Washington, D.C. office by telephone at (202) 530-1010. All correspondence should continue to be directed to our address given below.

Respectfully submitted,

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